

two cautions: one against reading limitations appearing only in the specification into claims that carry a plain broader meaning; the other requiring that claims be construed in light of the specification. How these principles apply in a particular case, however, “turns on how the specification characterizes the claimed invention.” *Alloc, Inc. v. Int’l. Trade Comm’n*, 342 F.3d 1361, 1370 (Fed. Cir. 2003), *cert. denied*, 541 U.S. 1063 (2004) (citing *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1305 (Fed. Cir. 2003)). Although “it is impermissible to read the one and only disclosed embodiment into a claim without other indicia that the patentee so intended to limit the invention[,] it is entirely permissible [] to limit the claims . . . where the specification makes clear at various points that the claimed invention is narrower than the claim language might imply.” *Id.* (citing *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002); *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1345 (Fed. Cir. 2001)).

The Federal Circuit clearly followed these canons. First, when discussing whether the patented “recess” must be horizontal, the Federal Circuit found that the claims required a recess, without reference to its orientation, and that the patent specification did not restrict this definition to recesses oriented horizontally, as opposed to vertically. *See* Pet. App. at 13a. Second, when determining whether the patented “recess” had to be formed “directly under the cutting edge surface,” the Federal Circuit, *adopting Izumi’s argument*, concluded that such a limitation would be inconsistent with the patent specification, and therefore found that the district court’s claim construction was erroneous. *See id.* at 12a. Third, when determining whether the ‘749 Patent described a recess with a cutout angle θ of 90 degrees or less, the Federal Circuit found that “the specification is not describing

an embodiment of the disclosed invention, but rather defining a critical aspect of the invention itself,” and therefore concluded that the word “recess,” as used in the ‘749 Patent, should be construed more narrowly than the claim language might imply in a vacuum. *Id.* See also, *Alloc*, 342 F.3d at 1370 (citing *SciMed*, 242 F.3d at 1345).

Nor did Judge Linn, in dissent, disagree with the principles of law followed by the majority; instead, Judge Linn disagreed with the majority’s application of well-settled principles of claim construction. Indeed, Judge Linn explicitly admitted that the specification can: (1) impose “an essential component of the invention” that must be read into the claim; (2) “disclaim[] the use of the invention in the absence of” aspects described in the specification; or (3) “specifically disclaim[] non-disclosed embodiments.” Pet. App. at 19a (quoting *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 908 (Fed. Cir. 2004) and citing *SciMed*, 242 F.3d at 1337). In short, Judge Linn accepted that the court can refer to the specification in interpreting the claims, even relying on the specification to define the claim. Judge Linn’s only disagreement was in the reading of the specification – unlike the majority, Judge Linn did not believe that a cutout angle θ of 90 degrees or less was an essential component of the invention. See *id.*

REASONS FOR DENYING THE PETITION

I. Petitioner has not articulated a compelling reason to justify discretionary review by this Court.

“Review on a writ of certiorari is not a matter of right, but of judicial discretion.” Sup. Ct. R. 10. “A petition for a writ of certiorari will be granted only for compelling reasons.” *Id.* Izumi has not presented any compelling reason for this Court to exercise discretionary jurisdiction over its attempted appeal of the Federal Circuit’s interpretation of the ‘749 Patent.

First, this case arises from an unpublished opinion that therefore has no precedential value. *See Izumi*, 140 Fed. Appx. at 236 (unpublished opinion); Fed. Cir. R. 47.6(b) (“An opinion or order which is designated as not to be cited as precedent is one determined by the panel issuing it as not adding significantly to the body of law. Any opinion or order so designated must not be employed or cited as precedent”). Second, Izumi attempts to manufacture an issue meriting review by arguing that the law on the proper use of the specification in construing patent claims evidences a “deep intracircuit split” that results in “inherent uncertain[ty]” and “unpredictability.” Pet. at 12-14. Having tried to persuade this Court that there is a molehill where there is only flat ground, Izumi proceeds to manufacture a mountain out of this ephemeral molehill, asserting that the Federal Circuit’s long-established methodology for interpreting claims has created a “‘zone of uncertainty which . . . discourag[e]s invention only a little less than unequivocal foreclosure of the field.’” *Id.* at 12 (quoting *Markman v. Westview Instruments, Inc.* (*Markman II*), 517 U.S. 370, 390 (1996)). As discussed below, Izumi is wrong on all points.

A. This case does not implicate any intracircuit or intercircuit split of authority.

The principles governing the proper use of a patent's specification in construing claims are well-settled and easily summarized. To ascertain the meaning of claims, the court considers three sources: the claims, the specification, and the prosecution history. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) ("*Markman I*"), *aff'd*, 517 U.S. 370 (1996) (quoting *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561 (Fed. Cir. 1991)). Claim construction begins with the words of the claim. *Teleflex*, 299 F.3d at 1324. Claim terms generally take their ordinary meaning,⁴ if there is one. *Id.* at 1325. But claims must be read in view of the specification, which "may act as a sort of dictionary, which explains the invention and may define terms used in the claims." *Markman I*, 52 F.3d at 979. Although not at issue here, the prosecution history has also long been recognized as a vital source for the proper construction of the claims. *Id.* at 980 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966) and *Autogiro Co. v. United States*, 384 F.2d 391, 397 (Ct. Cl. 1967)); *see Teleflex*, 299 F.3d at 1326.

4. The ordinary meaning of the words of a claim "is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc), *cert. denied*, ___ U.S. ___, 2006 WL 386393 (Feb. 21, 2006). "The ordinary and customary meaning of a claim term may be determined by reviewing a variety of sources, which may include the claims themselves; dictionaries and treatises; and the written description, the drawings, and the prosecution history." *Gemstar-TV Guide Int'l., Inc. v. Int'l. Trade Comm'n*, 383 F.3d 1352, 1364 (Fed. Cir. 2004) (citing *Ferguson Beauregard v. Mega Sys., LLC*, 350 F.3d 1327, 1338 (Fed. Cir. 2003)).

Thus, there is no “intracircuit split” to be resolved – it is widely agreed that “ordinary meaning” does not control a claim term’s construction where, for example, the patentee sets forth a definition of the disputed claim term in either the specification or prosecution history; the specification or file history shows that the patentee limited the scope of the claims (by, for example, describing a particular embodiment as important to the invention); the claim term deprives the claim of meaning such that definite meaning can be determined only by reference to the specification and file history; or the claim is phrased in step- or means-plus-function format. *See CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366-67 (Fed. Cir. 2002). Indeed, there is no question that “the specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc), *cert. denied*, ___ U.S. ___, 2006 WL 386393 (Feb. 21, 2006) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). *See also id.* at 1313 (“the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification”); *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005) (“We cannot look at the ordinary meaning of the term . . . in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history”) (citation omitted). These principles are long-established.

Contrary to Izumi’s contention (*see* Pet. at 21-22), these principles are in full accord with this Court’s pronouncements on claim construction. It has long been established that “an

invention is construed not only in light of the claims, but also with reference to the file wrapper or prosecution history . . . Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art.” *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966). This Court, in *Markman II*, holding that judges, not juries, should construe claims, relied critically on the settled principle that claim construction entails a “necessarily sophisticated analysis of the whole document,” so that terms are defined to “comport [] with the instrument as a whole.” 517 U.S. 370, 389 (1996). More recently, in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002), the Court approved the context-specific principles of claim construction laid out in *Autogiro*, 384 F.2d at 397.

In short, there is no divide, whether in the Federal Circuit or this Court, about the importance of the specification in understanding the meaning of the claims in a patent. This case is a perfect example: even though Izumi attempts to characterize Judge Linn’s dissent as evidence of a deep doctrinal divide, the dissent instead simply demonstrates the old aphorism that, even when confronted with the same facts and rules, reasonable people can disagree reasonably. Judge Linn does not even imply that the specification is irrelevant when determining the scope of the ‘749 Patent – rather, whereas the majority reads the specification requiring a cutout angle of 90 degrees or less as “defining a critical aspect of the invention itself,” Judge Linn believes that the cutout angle is not essential to the ‘749 Patent. *See* Pet. App. at 12a, 19a. This is not a matter of principle or policy. It is a matter of interpretation of the specification language, and nothing more.

B. The Federal Circuit recently directly addressed the issues raised by Petitioner, and this Court denied *certiorari* in that case.

To the extent that Izumi attempts to identify tensions or confusion in the law, such issues are best resolved by the Federal Circuit, and do not merit the intervention of this Court. Indeed, the Federal Circuit recently did address the issue of which Izumi complains. As Izumi acknowledges, the Federal Circuit, sitting *en banc*, explicitly addressed “the extent to which [the Federal Circuit] should resort to and rely on a patent’s specification in seeking to ascertain the proper scope of its claims.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*), *cert. denied*, ___ U.S. ___, 2006 WL 386393 (Feb. 21, 2006). *See* Pet. at 15. This, of course, is precisely the question that Izumi asserts is at issue in this case. *Phillips*, moreover, resolved the question, reiterating and restating the principles described above and supported for generations by both this Court and the Federal Circuit. *See Phillips*, 415 F.3d at 1315 (“[t]he descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims”) (quoting *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985)); *id.* at 1316 (collecting Supreme Court cases standing for the proposition that “[I]t is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention”) (quoting *United States v. Adams*, 383 U.S. 39, 49 (1966)).

Izumi recognizes that *Phillips* provided, at the very least, what Izumi terms a “compromise.” *See* Pet. at 15. Izumi,

however, complains that, rather than cementing the well-established jurisprudence regarding the interplay between a patent's claims and its specification, *Phillips* confused the issue.⁵ See *id.* (“[i]n retaining elements of both approaches, *Phillips*’ compromise solution carried little promise of bringing certainty to the field”). Izumi is wrong, and this Court has already so found: twenty-two days after Izumi filed its petition for *certiorari*, this Court denied *certiorari* in *Phillips*. See *AWH Corp. v. Phillips*, ___ U.S. ___, 2006 WL 386393 (Feb. 21, 2006). The Federal Circuit, moreover, has had no difficulty understanding the rule set out in *Phillips*. See, e.g., *Nystrom v. TREX Co., Inc.*, 424 F.3d 1136, 1145 (Fed. Cir. 2005) (“What *Phillips* now counsels is that in the absence of something in the written description and/or prosecution history to provide explicit or implicit notice to the public – i.e., those of ordinary skill in the art—that the inventor intended a disputed term to cover more than the ordinary and customary meaning revealed by the context of the intrinsic record, it is improper to read the term to encompass a broader definition simply because it may be found in a dictionary, treatise, or other extrinsic source”) (citing *Phillips*, 415 F.3d at 1321). Izumi offers no reason why this case – which incorporates, in a case-specific manner, the methodology approved in *Phillips* – merits this Court’s review when *Phillips*, which addressed the issue directly, did not.

5. Indeed, Izumi suggests that it should, at least, be granted *certiorari* in this Court as a companion case to *Phillips*. See Pet. at 2-3 n.1.

C. This case does not implicate any issues of significant interest to this Court.

This case is nothing more than a simple disagreement among judges about whether the specification in the '749 Patent helped to define the meaning of the term "recess" in the claims. It is not a case of policy, nor should it be elevated to one. As the *Phillips* court recognized:

In the end, there will still remain some cases in which it will be hard to determine whether a person of skill in the art would understand the embodiments to define the outer limits of the claim term or merely to be exemplary in nature. While that task may present difficulties in some cases, we nonetheless believe that attempting to resolve that problem in the context of the particular patent is likely to capture the scope of the actual invention more accurately than either strictly limiting the scope of the claims to the embodiments disclosed in the specification or divorcing the claim language from the specification.

Phillips, 415 F.3d at 1323-24.

Izumi attempts to create an issue of national policy where there is none by asserting that reference to the specification diminishes or otherwise undercuts the claims language, thereby placing the entire United States patent system in jeopardy. *See* Pet. at 20-24. But this Court's decisions, as just noted, and the long line of decisions in the Federal Circuit and its predecessor courts, make clear that the claims are *not* undervalued when the specification and prosecution history

are examined in just the ways the Federal Circuit did in this case. As the Federal Circuit explained in *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, “a construing court does not accord the specification, prosecution history, and other relevant evidence the same weight as the claims themselves,” but refers to these sources to give the claim language its proper context. 114 F.3d 1547, 1552 (Fed. Cir. 1997); see also *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 957 (Fed. Cir. 1983) (“That claims are interpreted in light of the specification does not mean that everything in the specification must be read into all the claims.”); *SRI Int’l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (the specification and file history are useful but the focus remains on the claims). Indeed, the Federal Circuit in this case did not attempt to read the entire specification as a limitation, but only that part that it determined “defin[ed] a critical aspect of the invention itself.” Pet. App. at 12a.

Izumi additionally complains that “[t]his elevation of the enabling disclosure over the claims violates 35 U.S.C. § 112.” Pet. at 21. As described throughout this brief, both this Court and the Federal Circuit have long agreed that, although the claims are the primary source of interpretation of patent, the claims *must* be read in the context of the patent as a whole. In order to marshal authority for its apparent position that the specification in a patent should have little, if any, impact under 35 U.S.C. § 112, Izumi relies on a statement of general principle by this Court in *Smith v. Snow*, 294 U.S. 1, 11 (1935). See Pet. at 22.

Izumi also reads this Court’s statement of general principle in *Smith* without the context of the opinion as a whole. Immediately after the Court pronounced its general principle, however, it engaged in precisely the form of

analysis performed by the Federal Circuit in this case: determining whether the specification was essential to the claim in order to establish the scope of the claims. *See Smith*, 294 U.S. at 11 (“Here the specifications showed an arrangement of the eggs and a means of guiding the current of air so that it would reach the most advanced eggs first. *But neither the arrangement nor the means of guiding the current of air are requisite to the application of the principle which Smith discovered and claimed*”) (emphasis added). Indeed, the Court continued to examine the prosecution history and prior art in order to determine if either limited the patent’s claim. *See id.* at 14-16.

The enabling disclosure, moreover, is required by, rather than in conflict with, 35 U.S.C. § 112, which “makes the enabling disclosure operational as a limitation on claim validity.” *Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1070 (Fed. Cir. 2005). *See also, Phillips*, 415 F.3d at 1316 (“In light of the statutory directive that the inventor provide a ‘full’ and ‘exact’ description of the claimed invention, the specification necessarily informs the proper construction of the claims”).

Izumi’s refusal – in the face of an abundance of caselaw to the contrary – to recognize virtually any role for the specification in claim construction may be why Izumi concludes that there is “unpredictability” in the Federal Circuit’s application of its claim construction principles and that certain Federal Circuit opinions are “conflicting.” Pet. at 14. However, the fact that particular specifications have greater or lesser weight in different cases is simply the result of the fact that the inquiry as to the meaning of claims is inevitably context-specific. The Federal Circuit has explained the unavoidable patent-specificity of the inquiry:

“Whether an invention is fairly claimed more broadly than the ‘preferred embodiment’ in the specification is a question specific to the content of the specification, the context in which the embodiment is described, the prosecution history, and if appropriate the prior art.” *Teleflex*, 299 F.3d at 1327. See also, e.g., *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998) (“there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification”). While the particular application of the principles sometimes provokes disagreements, there is no need or warrant for this Court to review the principles of claim construction regularly being applied in the Federal Circuit.

II. The Federal Circuit’s application of well-settled principles of law to the facts of this case was correct.

Izumi also attempts to cast the court of appeals’ claim construction in this case – a necessarily context-specific inquiry – as an issue meriting review. Izumi’s main argument is that the court below accorded too much weight to the specification. Pet. at 20. This argument fails because the majority properly applied correct principles of claim construction in reaching a decision.

The court below properly interpreted the claims, reviewing the specification in order to determine what the claim terms meant in context and, in particular, whether the inventors had limited the claims to make clear that a cutout angle θ of 90 degrees or less was required. See Pet. App. at 12a. The court concluded that the specification did “not describe[e] an embodiment of the disclosed invention, but rather defin[ed] a critical aspect of the invention itself.” This

method of analysis is perfectly consistent with this Court's principles of claim construction. *See generally, Markman II*, 517 U.S. 370.

In sum, Izumi's efforts to fashion an issue deserving of review by challenging the Federal Circuit's analysis in this case is unsuccessful. The decision below was correct and resulted from proper application of well-established principles of claim construction. In any event, Izumi's complaints relate only to patent-specific interpretation issues and are not appropriate for review by this Court.

CONCLUSION

For the reasons set out above, the Petition should be denied.

Respectfully submitted,

JOHN M. DiMATTEO

Counsel of Record

MICHAEL D. MAIMIN

WILLKIE FARR & GALLAGHER LLP

787 Seventh Avenue

New York, NY 10019

(212) 728-8000

Counsel for Respondents

No. 05-961

Supreme Court, U.S.
FILED

MAR 17 2006

OFFICE OF THE CLERK

In the Supreme Court of the United States

IZUMI PRODUCTS COMPANY,

Petitioner,

v.

KONINKLIJKE PHILIPS ELECTRONICS N.V.,
PHILIPS ELECTRONICS NORTH AMERICA CORPORATION, AND
PHILIPS DOMESTIC APPLIANCE AND PERSONAL CARE B.V.,
Respondents.

**On Petition for a Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit**

REPLY BRIEF FOR PETITIONER

HAROLD A. BARZA
KENT J. BULLARD
VALERIE M. NANNERY
*Quinn Emanuel Urquhart
Oliver & Hedges, LLP*
865 S. Figueroa Street
Los Angeles, CA 90017
(213) 443-3000

DAVID T. GOLDBERG
99 Hudson Street, 8th Flr.
New York, NY 10013
(212) 334-8813

KATHLEEN M. SULLIVAN
(Counsel of Record)
DANIEL BROMBERG
*Quinn Emanuel Urquhart
Oliver & Hedges, LLP*
555 Twin Dolphin Drive
Redwood Shores, CA 94065
(650) 801-5000

SANFORD I. WEISBURST
JAMES M. GLASS
KETEVAN KULIDZHANOVA
*Quinn Emanuel Urquhart
Oliver & Hedges, LLP*
335 Madison Avenue, 17th Flr.
New York, NY 10017
(212) 702-8100

Counsel for Petitioner

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES.....	ii
I. THERE IS AN IMPORTANT AND UNRESOLVED CONFLICT OVER THE PROPER USE OF ENABLING DISCLOSURES IN PATENT CLAIM CONSTRUCTION.....	2
II. RESPONDENTS OFFER LITTLE DEFENSE OF THE ENABLING DISCLOSURE-FOCUSED APPROACH EXEMPLIFIED BY THE DECISION BELOW.	7
III. THIS CASE PROVIDES AN EXCELLENT VEHICLE FOR RESOLVING THE LONGSTANDING CONFLICT OVER THE PROPER USE OF ENABLING DISCLOSURES IN PATENT CLAIM CONSTRUCTION.....	9
CONCLUSION	10

TABLE OF AUTHORITIES

Page(s)

CASES

<i>Bates v. Coe</i> , 98 U.S. 31 (1878)	9
<i>Briggs & Stratton Corp. v. Kohler Co.</i> , 408 F. Supp. 2d 697 (W.D. Wis. 2006)	5
<i>Domino's Pizza, Inc. v. McDonald</i> , 544 U.S. 998 (2005), decided, -- U.S. -- (Feb. 22, 2006) ...	2
<i>Dorel Juvenile Group v. Graco Children's Prods., Inc.</i> , 429 F.3d 1043 (Fed. Cir. 2005)	5, 6
<i>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.</i> , 535 U.S. 722 (2002)	9
<i>Free Motion Fitness, Inc. v. Cybex Int'l, Inc.</i> , 423 F.3d 1343 (Fed. Cir. 2005)	5, 6
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	9
<i>Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc.</i> , 534 U.S. 1016 (2001), decided, 535 U.S. 826 (2002)	2
<i>Housey Pharms., Inc. v. Astrazeneca UK Ltd.</i> , 366 F.3d 1348 (Fed. Cir. 2004)	3
<i>Markman v. Westview Instruments, Inc.</i> , 517 U.S. 370 (1996)	6
<i>McCarty v. Lehigh Valley R. Co.</i> , 160 U.S. 110 (1895)	8

TABLE OF AUTHORITIES – continued

	Page(s)
<i>Merck & Co. v. Teva Pharms. USA, Inc.</i> , 395 F.3d 1364 (Fed. Cir. 2005)	3
<i>nCube Corp. v. Seachange Int'l, Inc.</i> , 436 F.3d 1317 (Fed. Cir. 2006)	5
<i>Phillips v. AWH Corp.</i> , 376 F.3d 415 (Fed. Cir. 2004) (<i>per curiam</i>) (granting <i>en banc</i> review), decided, 415 F.3d 1303 (2005) (<i>en banc</i>), cert. denied, No. 05-602, Feb. 21, 2006.	2, 4, 5, 6
<i>SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.</i> , 242 F.3d 1337 (Fed. Cir. 2001)	4
<i>Smith v. Snow</i> , 294 U.S. 1 (1935)	8
<i>Texas Digital Sys., Inc. v. Telegenix, Inc.</i> , 308 F.3d 1193 (Fed. Cir. 2002)	3
<i>Vitronics Corp. v. Conceptronic, Inc.</i> , 90 F.3d 1576 (Fed. Cir. 1996)	3
<i>Williams v. Overton</i> , No. 05-7142, cert. granted, March 6, 2006	2
<i>Zurich Ins. Co. v. Chatham County</i> , No. 04-1618, cert. granted, Oct. 11, 2005	2
 STATUTES, RULES AND REGULATIONS	
35 U.S.C. § 112	1, 7, 8

TABLE OF AUTHORITIES – continued

	Page(s)
MISCELLANEOUS	
C. Cotropia, <i>Observations on Recent Patent Decisions: The Year in Review</i> , 88 J. PAT. & TRADEMARK OFF. SOC'Y 46 (2006).....	5
D. Strauss, <i>Why Plain Meaning?</i> , 72 NOTRE DAME L. REV. 1565 (1997).....	6
D. Wolfsohn & A. Goranin, <i>Phillips v. AWH: The Federal Circuit's Missed Opportunity</i> , THE LEGAL INTELLIGENCER, Sept. 14, 2005, at 8.....	5
H. SCHWARTZ, PATENT LAW AND PRACTICE (4th ed. 2003).10	
J. Molenda, <i>Understanding the Federal Circuit's Internal Debate and its Decision To Rehear Phillips v. AWH Corp. En Banc</i> , 86 J. PAT. & TRADEMARK OFF. SOC'Y 911 (2004).....	4
K. Llewellyn, <i>Remarks on the Theory of Appellate Decision and the Rules or Canons About How Statutes Are To Be Construed</i> , 3 VAND. L. REV. 395 (1950)	3
P.J. Federico, <i>Commentary on the New Patent Act</i> , 35 U.S.C.A. Vol. 1, p. 25 (1954).....	7
Petition for a Writ of Certiorari in <i>AWH Corp. v. Phillips</i> , No. 05-602, filed Nov. 9, 2005.....	1
R. HARMON, PATENTS AND THE FEDERAL CIRCUIT (7th ed., 2006 Supp.)	6

TABLE OF AUTHORITIES – continued

	Page(s)
R. Wagner & L. Petherbridge, <i>Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance</i> , 152 U. PA. L. REV. 1105 (2004).....	6
Respondent's Brief in Opposition in <i>AWH Corp. v. Phillips</i> , No. 05-602, filed Jan. 3, 2006	2

REPLY BRIEF FOR PETITIONER

Izumi's petition documented the deep and widely recognized division within and among panels of the Federal Circuit concerning how to interpret patent claims in light of enabling disclosures. The petition explained that this division leads to uncertainty regarding the scope of patents, which in turn impedes efficient investment in innovation and spawns infringement litigation.

The petition also demonstrated that, uncertainty aside, the methodology employed by the panel majority's decision below (which exemplifies one line of Federal Circuit precedent), by allowing the enabling disclosure to define claim terms by implication, contravenes Congress' careful separation in 35 U.S.C. § 112 of the claims element from the enabling disclosure element and thus undermines the latter's function.

Finally, the petition explained that this case is an ideal vehicle for this Court to resolve the methodological debate because in this case, the choice of methodology determines the outcome: the ordinary meaning of the claim term "recess" does not support an angular limitation, and only by relying on an inference from the enabling disclosure was the majority below able to narrow the scope of the claims. Respondents have no answer to these arguments, which they either sidestep or ignore altogether. Review by this Court is plainly warranted.

This Court's denial of certiorari in *Phillips*, No. 05-602, is beside the point. The *Phillips* petitioner curiously chose *not* to present the question of patent interpretation methodology that Izumi presents here, despite the fact that the *en banc* court in *Phillips* devoted considerable attention to it. Instead, the *Phillips* petitioner presented the entirely different question whether the *de novo* standard governs appellate review of a district court's patent interpretation, see Pet. for cert. in No. 05-602, at i, a question the *en banc* majority in *Phillips*

expressly declined to address. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1328 (Fed. Cir. 2005). (The *Phillips* respondent in turn opposed certiorari on grounds also wholly inapposite here, including that the *en banc* majority failed to address the standard of review question and that the case was in an interlocutory posture. Br. in Opp. in No. 05-602, at 6–8.)

Thus, respondents mislead this Court in describing (Opp. 11) the *Phillips* petition as presenting the same question that Izumi presents in this petition.¹ To the contrary, this case presents the very question the *Phillips en banc* decision addressed but the *Phillips* petitioner chose *not* to pursue. Its resolution remains of vital importance to patent litigants despite the denial of certiorari in *Phillips*.

I. THERE IS AN IMPORTANT AND UNRESOLVED CONFLICT OVER THE PROPER USE OF ENABLING DISCLOSURES IN PATENT CLAIM CONSTRUCTION.

1. Respondents simply ignore the deep division in the Federal Circuit's case law before *Phillips*, instead describing the Circuit's pre-*Phillips* decisions as involving nothing more than application of "well-settled" principles. Opp. 7. This suggestion is flatly contradicted by repeated statements by members of the Federal Circuit itself describing and lamenting a profound intracircuit conflict, and by the uniform view

¹ Nor, contrary to respondents' suggestion (Opp. 6), is it relevant that the decision below was unpublished. This Court routinely grants certiorari without regard to whether the decision below was published. See, e.g., *Williams v. Overton*, No. 05-7142, cert. granted, March 6, 2006; *Zurich Ins. Co. v. Chatham County*, No. 04-1618, cert. granted, Oct. 11, 2005; *Domino's Pizza, Inc. v. McDonald*, 544 U.S. 998 (2005); *Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc.*, 534 U.S. 1016 (2001) (patent case arising from Federal Circuit).

of commentators. That this conflict has arisen notwithstanding the "well settled" principles respondents identify is hardly surprising, for those principles (and counter-principles) are phrased so abstractly that they provide little practical guidance. Cf. K. Llewellyn, *Remarks on the Theory of Appellate Decision and the Rules or Canons About How Statutes Are To Be Construed*, 3 VAND. L. REV. 395 (1950).

As the petition described (at 5, 14), the Federal Circuit has developed two competing and inconsistent approaches to patent interpretation, one focusing on patent claims and the other using enabling disclosures to redefine those claims. Compare, e.g., *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204 (Fed. Cir. 2002) (claim-focused approach) (prohibiting "[c]onsult[ation] [of] the written description * * * as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves * * *") (emphasis added), with *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (enabling disclosure-focused approach) (enabling disclosure may "defin[e] [claim] terms by implication"). Only by ignoring one side of this conflict (*Texas Digital* and progeny) can respondents deny (Opp. 7-8) that the conflict exists.

As the petition outlined (at 15), and respondents ignore, repeated statements by Federal Circuit judges expressly acknowledge and bemoan this deep intracircuit split and the confusion it engenders among litigants and the lower courts. See, e.g., *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1377 (Fed. Cir. 2005) (Rader, J., dissenting) (the Circuit's "claim constructions wave[r] between the plain meaning rule * * * and the 'specification über alles' rule"); *Housey Pharms., Inc. v. Astrazeneca UK Ltd.*, 366 F.3d 1348, 1357 (Fed. Cir. 2004) (Newman, J., dissenting) ("This case again illustrates the conflict generated in the court's recent jurisprudence of claim construction."). As Judge Dyk aptly observed in his concurrence in *SciMed Life Systems*,

Inc. v. Advanced Cardiovascular Systems, Inc., 242 F.3d 1337, 1347 (Fed. Cir. 2001), "The problem is that our decisions provide inadequate guidance as to when it is appropriate to look to the specification to narrow the claim by interpretation and when it is not appropriate to do so. Until we provide better guidance, I fear that the lower courts and litigants will remain confused."

Indeed, the *en banc* court in *Phillips* explicitly recognized the conflict in its order granting review. See 376 F.3d at 1383 (acknowledging the view of "the claim construction methodologies in the majority and dissent of the now-vacated panel decision as alternative, conflicting approaches").² See also 415 F.3d at 1319 ("some of this court's cases have suggested a somewhat different approach to claim construction"). In short, the existence of an intracircuit conflict is undeniable.

2. As the petition explained (at 15–16), the *en banc* court in *Phillips*, despite its best efforts, failed to resolve the disagreement, instead "restating * * * the basic principles of claim construction outlined [in the pre-*Phillips* cases]" (*ibid.*) and thus leaving the Circuit's judges in future cases free to invoke either set of principles. To quote the *Phillips* dissent, "The court's opinion today is akin to rearranging the deck chairs on the Titanic—the orchestra is still playing as if nothing is amiss, but the ship is still heading for Davey Jones' locker." 415 F.3d at 1334–35 (Mayer, J., dissenting, joined by Newman, J.). See also *id.* at 1330 ("[W]e say nothing new, but merely restate what has become the practice over

² Commentators uniformly understood the grant of *en banc* review as the Circuit's recognition of a conflict on patent interpretation methodology. See, e.g., J. Molenda, *Understanding the Federal Circuit's Internal Debate and its Decision To Rehear Phillips v. AWH Corp. En Banc*, 86 J. PAT. & TRADEMARK OFF. SOC'Y 911, 911 (2004).

the last ten years * * *"). Respondents offer no rebuttal to the *Phillips* dissent's assessment of *Phillips*.

The dissent's analysis is corroborated by the views of numerous commentators and by the continued pattern of division along methodological lines in the Circuit's infringement decisions. See Pet. 16–17. Again, respondents confront neither point.

First, multiple commentators have expressed the view that "[i]f courts and litigants must continue to rely on generic recitations of the same 'well-settled' construction principles, while guidance on thornier interpretative questions is avoided, there is little reason to hope that the ad hoc and inconsistent nature of claim construction will be ameliorated any time soon." D. Wolfsohn & A. Goranin, *Phillips v. AWH: The Federal Circuit's Missed Opportunity*, THE LEGAL INTELLIGENCER, Sept. 14, 2005, at 8. See also C. Cotropia, *Observations on Recent Patent Decisions: The Year in Review*, 88 J. PAT. & TRADEMARK OFF. SOC'Y 46, 51 (2006) (similar); Pet. 16 (citing a similar article and treatise).

Second, divisions in the Federal Circuit's patent interpretation decisions are just as frequent after *Phillips* as before. See *nCube Corp. v. Seachange Int'l, Inc.*, 436 F.3d 1317, 1326 (Fed. Cir. 2006) (Dyk, J., dissenting); *Dorel Juvenile Group v. Graco Children's Prods., Inc.*, 429 F.3d 1043, 1047 (Fed. Cir. 2005) (Newman, J., dissenting); *Free Motion Fitness, Inc. v. Cybex Int'l, Inc.*, 423 F.3d 1343, 1353 (Fed. Cir. 2005) (Prost, J., dissenting); Pet. App. 16a (Linn, J., dissenting).³ See also *Briggs & Stratton Corp. v. Kohler Co.*, 408 F. Supp. 2d 697, 699–700 (W.D. Wis. 2006) (under *Phillips*, "striking a balance between an overly restrictive and an overly broad construction can be as treacherous as navigating between Scylla and Charybdis"). And it is clear that the divi-

³ Though the panel decision below was decided before *Phillips*, rehearing was denied after *Phillips*. See Pet. App. 62a.

sions turn on the same broad methodological debate that raged before *Phillips*. See, e.g., *Free Motion*, 423 F.3d at 1355 (Prost, J., dissenting) ("The majority's approach, in my view, does not attempt to determine what the inventor actually invented, but rather takes the broadest available abstract meaning of a claim term that is not explicitly rejected by the specification."); *Dorel*, 429 F.3d at 1050 (Newman, J., dissenting) ("The majority's approach to claim construction strains this court's attempts [in *Phillips*] to restore consistency of analysis to patent claims by placing the claims in the context of the specification."); Pet. App. 16a (Linn, J., dissenting) (the majority "improperly reads a limitation from the specification into the claims"). These cases confirm that "*Phillips* does not provide a fix for this broken pillar of substantive patent law." R. HARMON, PATENTS AND THE FEDERAL CIRCUIT § 6.1(d), p. 51 (7th ed., 2006 Supp.).

3. Respondents do not contest the petition's showing that uncertainty in patent claim interpretation produces substantial, adverse effects on the economy by impeding efficient investment in innovation and spawning infringement litigation. See Pet. 17–18 (quoting *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996)). Nor do respondents dispute that greater certainty in claim interpretation is attainable if the proper methodology is adopted. See Pet. 20, 25–26; R. Wagner & L. Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. PA. L. REV. 1105, 1162 (2004) ("a small group [of Federal Circuit judges] is substantially consistent"; "this consistent group overlaps perfectly with the Proceduralist [*i.e.*, claim-focused] [methodology] * * *"). Cf. D. Strauss, *Why Plain Meaning?*, 72 NOTRE DAME L. REV. 1565, 1580 (1997) (the plain meaning approach to statutory interpretation has provided an "easy, relatively non-divisive way to resolve difficult issues").